

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTIAN COMPERA et al.

Appeal No. 2000-1491
Application No. 09/067,811

ON BRIEF

Before STONER, Chief Administrative Patent Judge, NASE and BAHR,
Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 7, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellants' invention relates to a device for conveying thin workpieces used in the printing technology field. An understanding of the invention can be derived from a reading of exemplary claim 1, the sole independent claim on appeal, reproduced below.

1. A device for conveying thin workpieces used in the printing technology field, comprising:
 - at least one moveable conveying element having an electrically insulating contact surface for supporting at least one of the workpieces as it is being conveyed, said conveying element formed without electrode material;
 - a d.c. voltage source supplying at least a first voltage potential; and
 - a plurality of contacts disposed to engage said contact surface of said conveying element, said plurality of contacts including a group of contacts electrically connected to said first voltage potential;
 - said plurality of contacts for applying regions of charge density to said conveying element to hold the workpiece on said contact surface of said conveying element.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bannai et al.	5,121,170	June 9,
1992		
(Bannai)		

Sugiyama	JP 61-124455	June 12, 1986 ¹
Kasahara	JP 06-171755	June 21, 1994 ²

Claims 1 to 7 stand rejected under 35 U.S.C. § 112 as being based on an inadequate disclosure and containing new matter.

Claims 1 to 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bannai or Sugiyama or Kasahara.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 13, mailed February 11, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 12, filed February 2, 2000) for the appellants' arguments thereagainst.

¹ A copy of the translation of Sugiyama provided by the USPTO is attached for the appellants' convenience.

² A copy of the translation of Kasahara provided by the USPTO is attached for the appellants' convenience. We direct the examiner's and the appellants' attention to Figure 7 of Kasahara and the related discussion thereof found on pages 3-4 of the translation.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The 35 U.S.C. § 112 Rejection

We will not sustain the rejection of claims 1 to 7 under 35 U.S.C. § 112.

In the answer, the examiner rejected claims 1 to 7 under 35 U.S.C. § 112 as being based on an inadequate disclosure and containing new matter. The full explanation of the rejection (answer, p. 5) is that

All of the claims require the conveying element to be "formed without electrode material". Applicants referred to page 8 lines 19-21 and page 13, lines 18-19 for support of the new claim language. Page 8, lines 19-21 states that there are "no electrodes" in the belt and page 13, lines 18-19 state that the belt is "formed of dielectric material". It is the examiner's understanding

that the dielectric material is made from the same material (conductive) that electrodes are made. Therefore, the claims are not supported by the original disclosure.

Our understanding of this rejection is that it is based on the written description requirement set forth in the first paragraph of 35 U.S.C. § 112.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellants do not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to

those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

With this as background, we turn to the examiner's rejection under 35 U.S.C. § 112.

Initially, we find the examiner's statement that "dielectric material is made from the same material (conductive) that electrodes are made" to be incorrect since "dielectric" is defined³ as "a nonconductor of electricity."

³ The American Heritage® Dictionary of the English Language, Third Edition copyright 1992 by Houghton Mifflin Company.

Thus, dielectric material is not the same material from which electrodes are made.

Secondly, it is our view the claimed limitation that the conveying element is "formed without electrode material" finds written description support in the original disclosure cited by the examiner. In that regard, the conveyor belt 1 is disclosed (specification, page 13, lines 18-19) as being "formed of a dielectric material" which means that the conveyor belt 1 is formed from nonconductive material (i.e., material not suited for conducting, or put another way, material not suitable for being an electrode). In addition, it is our view that the appellants' two-layer conveyor belt 301 does provide support for the conveying element being "formed without electrode material" since the inner surface of belt 301 is electrically conductive (i.e., made from material suitable for being an electrode).

For the reasons set forth above, the decision of the examiner to reject claims 1 to 7 under 35 U.S.C. § 112 is reversed.

The 35 U.S.C. § 103 Rejection

We will not sustain the rejection of claims 1 to 7 under 35 U.S.C. § 103.

In the answer, the examiner rejected claims 1 to 7 under 35 U.S.C. § 103 as being unpatentable over Bannai or Sugiyama or Kasahara. The full explanation of the rejection (answer, p. 4) is that

Applicants have disclosed plural equivalent embodiments (Figures 2, 4, 6, 8, 9, 10, 11, 12 and 14). Since the teachings in the three prior art devices are functional equivalents to the disclosed and claimed electrostatic charge attracting systems, the claims are obvious over those teachings.

The Supreme Court observed in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966):

While the ultimate question of patent validity is one of law, . . . the § 103 condition [that is, nonobviousness] . . . lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unresolved needs, failure of others,

etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Thus, initially, the scope and content of the applied prior art are to be determined. This the examiner has not done. Next, the differences between the applied prior art and the claims at issue are to be ascertained. The examiner has not ascertained the actual differences between the applied prior art (i.e., Bannai or Sugiyama or Kasahara) and the claims at issue (i.e., claims 1 to 7). Then, the examiner must determine if the ascertained differences between the subject matter sought to be patented and the prior art (i.e., Bannai or Sugiyama or Kasahara) are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. The examiner has not determined that the actual differences between the subject matter sought to be patented and Bannai or Sugiyama or Kasahara are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

art. Since the examiner has not made the above-noted determinations necessary to support a rejection under 35 U.S.C. § 103, the examiner has not established a prima facie case of obviousness⁴ and accordingly the decision of the examiner to reject claims 1 to 7 under 35 U.S.C. § 103 is reversed.

We remand the application to the examiner to (1) determine the scope and content of the applied prior art; (2) ascertain all the differences between Bannai or Sugiyama or Kasahara and claims 1 to 7; and (3) determine if the differences between the subject matter sought to be patented and Bannai or Sugiyama or Kasahara and any other relevant prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

⁴ In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the prior art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

person having ordinary skill in the art. In making this obviousness determination, we remind the examiner that to establish obviousness, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellants. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech.,

184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999).

The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 7 under 35 U.S.C. § 112 is reversed and the decision of the examiner to reject claims 1 to 7 under 35 U.S.C. § 103 is reversed. In addition, we have remanded the application to the examiner for further action.

This application, by virtue of its "special" status,
requires immediate action, see MPEP § 708.01 (Seventh Edition,
Rev. 1, Feb. 2000).

REVERSED; REMANDED

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Chief Administrative Patent Judge)	
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